

REMARKS

Claims 1-11 and 19-35 have been cancelled without prejudice. New claims 36-63 have been added. Support for the new claims can be found, for example, at page 3, lines 12-18 and page 9, lines 3-4 of the specification and in the original claims. Claims 12-18 and 36-63 are pending. Claims 12, 46 and 56 are independent.

Restriction requirement under 35 U.S.C § 121

Applicants affirm election of the invention of Group II, Claims 12-18, drawn to coated nanocrystals, as requested by the Examiner at page 2 of the Office Action. The election is made without traverse. New claims 36-63 read on the elected invention.

Rejection under 35 U.S.C § 102(b)

Claims 12-18 have been rejected under 35 U.S.C § 102(b) as being anticipated by WO 99/26299 to Bawendi *et al.* ("Bawendi '299"). See page 5 of the Office Action. Claims 13-18 depend from independent claim 12.

Bawendi '299 published on May 27, 1999. The present application claims priority from provisional application, U.S. Ser. No. 60/145,708 filed on July 26, 1999. Bawendi '299 published on May 27, 1999, which was within one year of the July 26, 1999, filing date of this application.

Bawendi '299 identifies Moungi Bawendi, Klavs Jensen, Bashire Dabbousi, Javier Rodriguez-Viejo and Frederic Victor Mikulec as inventors.¹ At best, Bawendi '299 qualifies as prior art under 35 U.S.C. § 102(a) based on the provisional application U.S. Ser. No. 60/145,708 which provides support for the claimed invention at, for example, page 4, lines 16-19, the examples and the original claims.

Applicants of the present claimed invention are Frederic Victor Mikulec, Moungi Bawendi and Sungjee Kim. It is well established that "one's own work is not prior art under §102(a) even though it has been disclosed to the public in a manner or form which would otherwise fall under 102(a)." *In re Katz*, 215 USPQ 14, 17 (CCPA 1982). Bawendi '299 describes a portion of the Applicants' own work and, therefore, is not citable against this application.

¹ While Bawendi '299 names "Iavier-Rodriguez-Vielo" as an inventor, his name is properly spelled "Javier Rodriguez-Viejo".

Applicant : Frederic Mikulec et al.
Serial No. : 09/625,861
Filed : July 26, 2000
Page : 6

Attorney's Docket No.: 01997-276001 / MIT 8529

The actual contributions of the co-inventors of Bawendi '299 (Bawendi, Jensen, Dabbousi, Rodriguez-Vielo and Mikulec) and Applicants (Mikulec, Bawendi and Kim) are clarified in a Declaration 37 C.F.R. § 1.132 of Moungi Bawendi, submitted herewith at Tab A. Dr. Bawendi states "Jensen, Dabbousi and Rodriguez-Viejo were not involved with any discovery or development of the concepts with regard to a nanocrystallite including a nanocrystalline core including MTe (where M is Cd, Zn, Mg or Hg) and an overcoating of a semiconductor material on a surface of the core." See paragraph three of the Bawendi Declaration. Any disclosure in Bawendi '299 relevant to the instantly claimed nanocrystalline a nanocrystallite core including MTe (where M is Cd, Zn, Mg or Hg) and an overcoating of a semiconductor material on a surface of the core is the work of the three co-inventors named in present application. Thus, Bawendi '299 does not qualify as prior art under 35 U.S.C. § 102(a).

For at least this reason, the rejection of claims 12-18 over Bawendi '299 should be withdrawn. Applicants, therefore, respectfully request the Examiner for reconsideration and withdrawal of this rejection.

Please call the undersigned to discuss any further concerns regarding this application.

CONCLUSION

Applicant asks that all claims be allowed. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 6-14-02



Harold H. Fox
Reg. No. 41,498

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331